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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/045,299	10/23/2001	Daniel Talbott		3244
7590	11/18/2003		EXAMINER	
DANIEL TALBOTT 642 N. ALBERTA STREET PORTLAND, OR 97217			PATTERSON, MARIE D	
			ART UNIT	PAPER NUMBER
			3728	
			DATE MAILED: 11/18/2003	9

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/045,299	TALBOTT, DANIEL	
	Examiner Marie Patterson	Art Unit 3728	

-- The MAILING DATE of this communication app ars on the cover sheet with the correspondence address --

#### Period for Reply

#### A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 25 September 2003.

2a) This action is FINAL.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-7 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-7 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. §§ 119 and 120

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

13) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
 a) The translation of the foreign language provisional application has been received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____	6) <input type="checkbox"/> Other: _____

***Specification***

**1. The following is a quotation of the first paragraph of 35 U.S.C. 112:**

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of 37 CFR 1.71(a)-(c):

(a) The specification must include a written description of the invention or discovery and of the manner and process of making and using the same, and is required to be in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which the invention or discovery appertains, or with which it is most nearly connected, to make and use the same.

(b) The specification must set forth the precise invention for which a patent is solicited, in such manner as to distinguish it from other inventions and from what is old. It must describe completely a specific embodiment of the process, machine, manufacture, composition of matter or improvement invented, and must explain the mode of operation or principle whenever applicable. The best mode contemplated by the inventor of carrying out his invention must be set forth.

(c) In the case of an improvement, the specification must particularly point out the part or parts of the process, machine, manufacture, or composition of matter to which the improvement relates, and the description should be confined to the specific improvement and to such parts as necessarily cooperate with it or as may be necessary to a complete understanding or description of it.

The specification is objected to under 37 CFR 1.71 because the specification, as originally filed, does not provide support for the invention as is now claimed.

1. It is noted that the Examiner has assumed that applicant is referring to element 104, i.e. the angular displacement member as the "rigid member" in claims, however, there is no basis in the specification for such. There is no disclosure as to what type of materials element 104 should be made from. There is no element in the specification which is referred to as a "rigid member", nor is there any disclosure of an element shaped as claimed, therefore the Examiner is left to assuming what applicant may be referring to in the claims.

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1. Claims 1-8 are rejected under 35 USC 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. See above.
2. Claims 1-7 are rejected under 35 USC 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 1 and 7 the phrase "substantially rigid member" and/or "an essentially rigid member" is confusing, vague, and indefinite as to what element(s) of applicants disclosure are being referred to with these phrases. It is not clear what elements/limitations applicant intends to encompass with these phrases.

In claims 1 and 7 the phrase "the tips of the digits portion of the plantar surface" and in claims 2 and 7 the phrases "the portion of the plantar surface that corresponds to the sesamoid apparatus..." lack proper antecedent basis rendering the claims vague and indefinite.

Claim 4 in its entirety is functional, confusing, and indefinite. It is not clear what structural limitations applicant intends to encompass with such language.

Claim 5 repeats limitations previously recited in claim 1 rendering claim 5 vague and indefinite as to what further structural limitations applicant intends to encompass with claim 5.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-5 and 7 are rejected under 35 USC 102 (b) as being anticipated by Daswick (4348821).

Daswick shows a shoe with a rigid member (10) with a foot strike member (at 16) and an angular displacement member (15 and/or 24), a balance thrust portion (front of element 20) and foot strike member (22) inasmuch as the claims are understood and defined in the claims.

5. Claims 1-8 are rejected under 35 USC 102 (e) as being anticipated by Whatley (2002/0026730).

Whatley shows a shoe with a rigid member (138/136), a foot strike member (38L), an angular displacement member (140), and a balance thrust portion (front of 140 and/or 36L) inasmuch as the claims are understood.

6. Claims 1-8 are rejected under 35 USC 102 (b) as being anticipated by Alexander (WO 92/14372).

Alexander shows a shoe with a rigid member (24) a foot strike member (rear of element 10), an angular displacement member (at 16 or other portions in that area),

and a balance thrust portion (forward portion of element 10) inasmuch as the claims are understood.

7. Claims 1- 8 are rejected under 35 USC 102 (b) as being anticipated by Spronken (4425721).

Spronken shows a shoe with a rigid member comprising a foot strike member (at 2), an angular displacement member (12 or area at 6), and balance thrust member (front at 4) inasmuch as the claims are understood.

### ***Response to Arguments***

8. Applicant's arguments filed 9/25/03 have been fully considered but they are not persuasive.

In response to applicants' arguments directed towards the objection/rejections based on the specification, applicant has not shown where the basis is in the specification. The portions referred to by applicant do not mention the elements objected to as being absent in the specification. It is noted that nowhere in the specification is the term "rigid" used. The fact that applicant used the term in the claims does not show where in the specification the basis for its use is.

In response to applicants' arguments directed towards Daswick, Whatley, Alexander and/or Spronken, the Examiner has clearly pointed out above how the limitations of the claims read on the references. The fact that a reference may not discuss applicants intended use does not mean that the reference does not read on applicants' claim language. The claims do not require any specific structure/material/etc. for the "angular

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displacement member", "the foot strike member", and/or the "balance thrust member", therefore the claim language reads on merely a layered sole with the second layer being the above mentioned members projecting below the first layer (i.e. the rigid member) or merely a single layer sole with curved elements/members such as shown by Spronken. The claims are extremely broad and indefinite as to what limitations are intended to be claimed. It is the claims that define the claimed invention, and it is claims, not specifications that are anticipated or unpatentable. *Constant v. Advanced Micro-Devices Inc.*, 7 USPQ2d 1064.

In response to Applicant's arguments directed towards the intended use, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

### ***Conclusion***

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

1. Telephone inquiries regarding the status of application or other general questions, by persons entitled to the information, "should be directed to the group clerical personnel and not to the Examiners. In as much as the official records and applications are located in the clerical section of the examining groups, the clerical personnel can readily provide status information without contacting the examiners", M.P.E.P. 203.08. The Group clerical receptionist number is (703) 308-1148 or the **Tech Center 3700 Customer Service Center number is (703) 306-5648**. For applicant's convenience, the Group Technological Center FAX number is (703) 872-9306. (Note that the Examiner **cannot** confirm receipt of faxes) Please identify Examiner\_\_\_\_ of Art Unit \_\_\_\_ at the top of your cover sheet of any correspondence submitted.

Inquiries only concerning the **merits** of the examination should be directed to Marie Patterson whose telephone number is (703) 308-0069.

If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g. copies of references cited, form PTO-1449, for PTO-892, etc. requests for copies of such papers should be directed to (703) 308-1337.

Check out our web-site at "[www.uspto.gov](http://www.uspto.gov)" for fees and other useful information.



Marie Patterson  
Primary Examiner  
Art Unit 3728